REMARKS

This Reply is filed with a Request for Continued Examination (RCE).

Claims 1-4, 6-15, 17-25, 27-28, 30-31, 33-49, 52, and 54-63 are presented for examination. Claims 1, 13, 17, and 52 are the independent claims. Claims 54-63 are new.

We do not concede the merits of the prior rejections; however, to expedite allowance, we have amended independent claims 1, 13, and 17 to include the subject matter of previously pending dependent claim 51 and amended claim 52 to include the subject matter of previously pending dependent claim 53. Furthermore, claim 17 has been further amended to cover subject matter described in the specification at, for example, page 4, last paragraph through page 5, second paragraph, and page 9, middle three paragraphs with reference to figures 2 and 3. Claims 6 and 8 have been amended so that they depend from claim 1, rather than from previously canceled claim 5.

Independent claims 1, 17, and 52 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Minoru (JP 2000294832, "Minoru"). Independent claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over Minoru in view of Han et al. (U.S. Publication No. 2001/0054761, "Han"). Previously pending dependent claims 51 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Minoru in view of Hochstein (U.S. Patent No. 6,517,218, "Hochstein").

With regard to independent claims 1, 13, 17, and 52 as presently amended, the Examiner concedes that Minoru does not disclose that "the thermal connecting part extends through the opening in the mount part and connects to the mount part at the opening to transfer heat away from the mount part," as presently recited in these claims. (See, action at page 7.) However, the action alleges that Hochstein discloses such features in figure 2 with respect to element 18 (the alleged "thermal connecting part") and element 30 (the alleged "mount part") and that "it would have been obvious at the time of the present invention to modify Minoru by having the thermal connecting part extending through the opening in the mount part to effectively dissipate heat away from the light emitting element to the outside." (Action at page 7.) We traverse.

Providing Minoru with a thermal connecting part that extends through an opening in a mount part is contrary to his stated objective of providing a device that is as thin as possible.

Specifically, Minoru states that one of the objects of his invention is to produce a LED illumination device that is miniaturized and has a thin profile (see, for example, Minoru, paragraphs 007, 008, and 0026), for integration with other miniaturized electronic components. To this end, Minoru's alleged thermal connecting part, metal plate 20, is supported by, but does not extend all the way through, resin matrix 10. On the other hand, Hochstein discloses a heat sink 18 that extends well beyond the opening in lead 14 to rest within heat dissipater 30. (See, for example, Figure 2, and col. 4, lines 1-30 of Hochstein.) There can be no reasonable dispute that modifying Minoru to include heat sink 18 as in Hochstein would significantly increase the thickness of Minoru's illumination device, contrary to his stated objective.

In view of Minoru's stated objective to produce a device with a reduced thickness, one skilled in the art would therefore not be motivated to modify Minoru to include a thermal connecting part of the type disclosed by Hochstein, because the resulting device would be thicker than the device disclosed by Minoru.

Furthermore, in order to transfer heat away from his mount part, Hochstein's thermal connecting part is seated in a heat dissipater 30. Therefore, if modified according to Hochstein to dissipate heat, Minoru's modified device would also include Hochstein's heat dissipater 30, which would further increase the thickness of Minoru's device, contrary to Minoru's stated objective of providing a device with reduced thickness. Thus, one skilled in the art would find no motivation to combine the teachings of Minoru and Hochstein, as alleged by the Examiner because Minoru itself teaches away from the proposed combination.

Moreover, even if, for the sake of argument, one skilled in the art would be motivated to combine the teachings of Minoru and Hochstein as proposed by the Action (which we do not concede), the rejection would still fail. Specifically, the action points to element 18 in as the claimed thermal connecting part and element 30 as the claimed mount part, however, the independent claims as presently amended, further require that the opening in the mount part extend "completely through the mount part." Heat dissipater 30 in Hochstein clearly does not have such an opening. (See, figure 2 in Hochstein.)

We further submit that Minoru and Hochstein clearly do not disclose additional features added to independent claim 17, such as "the housing is a surface mounted housing having a bearing surface for the surface mounting with the thermal connecting surface extending to the

bearing surface for conducting heat to an exterior surface to which the bearing surface mounts the housing."

Accordingly, we ask the Examiner to withdraw the rejection, and allow independent claims 1, 13, 17, and 52 as presently amended.

We also traverse the rejection of dependent claims 3 and 4, which limitations the Examiner disregards as "merely product by process and therefore do[] not structurally distinguish from Minoru." (Action at page 2.) To the contrary, the claims recite the type of connection between the thermal connecting part and the mount part. As such the claims explicitly, or at least implicitly, impart structure to the claimed leadframe, and therefore the limitations must be given patentable weight. See, for example, MPEP § 2113 ("The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.")

Applicants request that the application be allowed. Canceled claims have been canceled without prejudice or disclaimer. Any circumstance in which Applicants have: (a) addressed certain comments of the Examiner does not mean that Applicants concede other comments of the Examiner; (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims; or (c) amended or canceled a claim does not mean that Applicants concede any of the Examiner's positions with respect to that claim or other claims.

Enclosed is a $250.00 check for excess claim fees and a $450.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing 12406-127001.

Respectfully submitted,

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